REMARKS

No claims have been amended herein. After entry of this Letter To The Patent and Trademark Office, claims 1, 3-7, 9-20, and 23-25 will be pending.

As discussed more thoroughly below, Applicants assert that the Shannon et al. reference (U.S. 6,488,812) cited by the Office is not prior art under 35 U.S.C. 103(a) against the present invention as asserted by the Office. In support of this assertion, Applicants are enclosing herewith a copy of the Notice of Recordation and Assignment for the instant application indicating its assignment to Kimberly-Clark. Applicants respectfully request reconsideration and allowance of all pending claims.

1. Rejection of Claims 1, 3-4, 7, 9-14, and 17-20 Under 35 U.S.C. §103(a).

Reconsideration is respectfully requested of the rejection of claims 1, 3-4, 7, 9-14, and 17-20 under 35 U.S.C. § 103(a) as being unpatentable over Taylor (2,935,437) in view of Shannon et al. (6,488,812).

Independent claim 1 is directed to a process for making a cellulosic paper product and requires forming an aqueous suspension of papermaking fibers; introducing sodium bicarbonate into the aqueous suspension; depositing the aqueous suspension onto a sheet-forming fabric to form a wet web; and through-drying the wet web by passing heated air through the wet web.

Taylor discloses a process for making a pigment-filled paper of high brightness and opacity while reducing the losses of pigment in the papermaking machine. An aqueous suspension or slurry of papermaking fibers is formed to which is added finely divided hydrated amorphous calcium silicate while maintaining the

pH of the slurry of from 4 to 9.2 by addition of an acidic material. Acid salts such as sodium bicarbonate are included among the many disclosed acidic materials. The acidic material is said to react and form a water insoluble salt of the calcium silicate which precipitates and adheres firmly to the papermaking fibers in the slurry to reduce pigment losses in the papermaking machine. After precipitation of the calcium silicate on the cellulosic fiber surfaces, the slurry is sheeted into paper on the wire of a papermaking machine. The web is couched from the wire and subsequently dried, calendered and optionally coated according to conventional procedures (See col. 4, lines 48-59).

As conceded by the Office, Taylor fails to disclose any details of the method used to dry the web, much less teach that the web be through-dried by passing heated air through the web as required in claim 1.

Shannon et al. disclose a method of making a paper sheet which includes forming an aqueous suspension of papermaking fibers; depositing the suspension onto a sheet-forming fabric to form a web; and dewatering and drying the web to form a paper sheet. In accordance with the principal teaching of the disclosed method, a synthetic polymer having a portion of its structure derived from the polymerization of acrylamide and containing an aliphatic hydrocarbon moiety is added to the aqueous suspension of papermaking fibers. The synthetic polymer additive is said to reduce lint and slough in the paper sheet. Shannon et al. disclose various methods for drying the web. One such disclosed method includes using a canvas under tension to hold the partially dewatered web or sheet against a steam heated, convex surface metal dryer maintained at 213°F (101°C) for a period of two minutes (See col. 11, lines 6-55). Alternatively, Shannon et al. disclose through-air drying using supply air

heated to about 390°F (199°C) (See col. 14, lines 32-64). Shannon et al. do not disclose the use of sodium bicarbonate in the papermaking process.

In an attempt to remedy the shortcomings of each reference alone, the Office again combines these references together and states that it would have been obvious, to one skilled in the art at the time the invention was made, to combine the teachings of these references, because such a combination would provide quality drying of the formed paper product in the design of Taylor, since Shannon et al. teach 99% consistency of the final dried product.[1] As previously noted in Amendment A and in the Letter To The Patent And Trademark Office dated July 21, 2003 when the Office combined these two references, applicants respectfully submit that the Examiner's combination of Taylor and Shannon et al. in an attempt to overcome the admitted deficiencies of the primary reference fails to establish a *prima facie* case of obviousness under M.P.E.P. §2142 with respect to the claimed invention. Applicants maintain the prior arguments in that the Examiner has failed to show any motivation to combine the Taylor and Shannon et al. references. Notably, neither reference alone, or in combination, recognizes that the addition

[1]Applicants note that the Examiner has responded in the most recent Office action to applicants' arguments in Amendment A and in the Letter To The Patent And Trademark Office dated July 21, 2003 that there was not proper motivation to combine these references. The Office's response, however, is unsatisfactory as the Office simply restates, exactly, the same reason set forth in the Office actions without any further explanation. Such a response is tantamount to not responding to applicants' arguments, as further explanation and/or clarification was not provided. By making a conclusory statement without explanation, the Office has failed to meet its required burden under MPEP 2142, 4th Paragraph, of providing applicants with a convincing line of reasoning as to why the skilled artisan would have found claim 1 obvious.

of sodium bicarbonate in combination with through-air drying ultimately reduces odor in the product. Without such recognition, there is simply no motivation to combine these references and choose one specific method of drying over another.

In any event, Applicants assert that the Shannon et al. reference is not prior art against the pending patent application under 35 U.S.C. §103(a). The Shannon et al. reference cited by the Office has a priority date of December 14, 2000 based on its 35 U.S.C. §102(e)(1) application date.[2] However, as stated in 35 U.S.C. § 103(c), prior art which qualifies only under subsection (e) of section 102 does not preclude patentability where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. The Shannon et al. reference has been assigned to Kimberly-Clark Worldwide, Inc. as set forth on the first page of the 6,488,812 patent under "Assignee." Furthermore, the instant application has also been assigned to Kimberly-Clark Worldwide, Inc., as evidenced by the enclosed copy of the assignment. As such, Applicants assert that Shannon et al. cannot be a proper basis of rejection of the claims of the present application as Shannon et al. cannot be considered as prior art.

Because Shannon et al. is cited improperly as prior art, this rejection under 35 U.S.C. § 103(a) is improper and should be withdrawn. As such, claims 1, 3-4, 7, 9-14, and 17-20 are patentable over Taylor in view of Shannon et al.

[2]35 U.S.C. 102(e)(1) applies to an invention described in "an application for patent, published under § 122(b), by another filed in the United States before the invention by the applicant for patent...."

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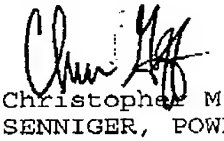
2. Rejection of Claims 5-6, 15-16, and 23-25 Under 35 U.S.C. § 103(a)

Reconsideration is respectfully requested of the rejection of claims 5-6, 15-16, and 23-25 under 35 U.S.C. § 103(a) as being unpatentable over Taylor (2,935,437) in view of Shannon et al. (6,488,812), and further in view of Espy (5,674,358).

For the reasons stated above, Shannon et al. has been improperly cited as prior art against the instant case under 35 U.S.C. § 103(a). Because Shannon et al. is cited improperly as prior art, this rejection under 35 U.S.C. § 103(a) is improper and should be withdrawn. As such, claims 5-6, 15-16, and 23-25 are patentable over Taylor in view of Shannon et al., and further in view of Espy.

In view of the above, Applicants respectfully request favorable reconsideration and allowance of all pending claims. The Commissioner is hereby authorized to charge any fee deficiency in connection with this Letter to Deposit Account Number 19-1345 in the name of Senniger, Powers, Leavitt & Roedel.

Respectfully Submitted,



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